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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,086	05/04/2001	Regina Johannesson	34650-00687USPT	9431

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EXAMINER

DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,086

Applicant(s)

JOHANNESSON ET AL.

Examiner

Temica M. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 12-15, 19, 20, 26-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Nizri et al (Nizri), U.S. Pub. No. 2002/0197992.

Regarding claims 1, 13, 26 and 31, Nizri discloses a method/terminal/circuitry for selecting a public land mobile network to serve a mobile station comprising the steps of: receiving at the mobile station a list of data associated with networks neighboring a PLMN currently serving the mobile station (0181-0182); selecting a new PLMN to serve the mobile station from the PLMNs neighboring the PLMN currently serving the mobile station based upon the list of data; and changing the mobile station to the selected new PLMN (0141-0142).

Regarding claims 2 and 27, Nizri discloses the list of data further comprises a list of PLMNs neighboring the PLMN currently serving the mobile station (0142 and 0181).

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Regarding claims 3, 14 and 28, Nizri discloses the list of data further comprises a list of PLMNs adjacent to the PLMN currently serving the mobile station (0107; figure 2).

Regarding claims 4, 15, and 29, Nizri discloses the list of data further comprises a list of PLMNs within a selected distance of the PLMN currently serving the mobile station (0107; figure 2).

Regarding claim 12, Nizri discloses the method of claim 1, further comprising the step of receiving a list of data in a MM information message (i.e., broadcast message) (Nizri, 0180-0181).

Regarding claim 19, Nizri discloses the method of claim 13, wherein the list of neighboring PLMN's further access technology (0017).

Regarding claim 20, Nizri discloses the method of claim 13, wherein the step of selecting further comprises the steps determining a better PLMN exists for serving the mobile station from the list of neighboring PLMNs; and scanning for the better PLMN (0010-0015).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5-7, 21-25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nizri in view of Pinault et al (Pinault), U.S. Patent No. 5,809,416.

Regarding claims 5 and 30, Nizri discloses the method of claims 1 and 26 as described above and further discloses wherein a neighbor list broadcast to a mobile station can include location area information (0181) . Nizri, however, fails to disclose wherein the location area comprises at least one mobile country code associated with a network neighboring the PLMN currently serving the mobile station.

In a similar field of endeavor, Pinault discloses a device for seeking connection of a terminal to a network of a mobile radio system comprising a plurality of networks. Pinault further discloses wherein the location area information comprises at least one mobile country code associated with a network neighboring a PLMN currently serving the mobile station (col. 4, line 61-col. 5, line 10).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Nizri with the teachings of Pinault for the purpose allowing a user of the terminal to know which country they are in. Such a feature could help the user in knowing which features or services he/she could or could not use.

Regarding claim 6, the combination of Nizri and Pinault discloses the method of claim 5 wherein the step of selecting further comprises the step of: determining if the at least one mobile country code is associated with a preferred PLMN of the mobile station; and selecting the preferred PLMN of the mobile station as the new PLMN if the mobile country code is associated with the preferred PLMN (Pinault, col. 4, line 61-col. 5, line 10).

Regarding claim 7, the combination of Nizri and Pinault discloses the method of claim 5, wherein the preferred PLMN comprises a home PLMN of the mobile station (Pinault, col. 4, lines 61-64).

Regarding claim 21, Nizri discloses a method for selecting a preferred PLMN to a serve a mobile station, comprising the steps of transmitting from a base station associated with a serving PLMN to the mobile station, location area information associated with a neighboring network (0081, 0115, 0180); selecting the preferred PLMN as a new serving PLMN (0141, 0142) if the at least location area is associated with the preferred PLMN (i.e., a PLMN that's not on a forbidden list) (0154), scanning for the preferred PLMN and changing the mobile station to the preferred PLMN (0141, 0142).

Nizri, however, fails to disclose wherein the location area information is a country code.

Pinault further discloses this information (col. 4, line 61-col. 5, line 10).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Nizri with the teachings of Pinault for the purpose allowing a user of the terminal to know which country they are in. Such a feature could help the user in knowing which features or services he/she could or could not use.

Regarding claim 22, the combination of Nizri and Pinault discloses the method of claim 22 wherein the step of selecting further comprises the step of: determining if the at least one mobile country code is associated with a preferred PLMN of the mobile station; and selecting the preferred PLMN of the mobile station as the new PLMN if the

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mobile country code is associated with the preferred PLMN (Pinault, col. 4, line 61-col. 5, line 10).

Regarding claim 23, the combination of Nizri and Pinault discloses the method of claim 21, further comprising the step of receiving a list of data in a MM information message (i.e., broadcast message) (Nizri, 0180-0181).

Regarding claim 24, the combination of Nizri and Pinault discloses the method of claim 21, wherein the preferred PLMN comprises a home PLMN of the mobile station (Pinault, col. 4, lines 61-64).

Regarding claim 25, the combination of Nizri and Pinault discloses the method of claim 21 as described above and further discloses broadcasting a neighbor list to a mobile station (Nizri, 0180, 0181). The combination, however, fails to particularly teach where and how often to broadcast the list.

However, the examiner believes that the above limitation would not render the claims patentable over the applied references because it merely depends on where and how often one would like to broadcast the list, without changing the scope of the invention in the applied references. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention, to broadcast the system list at various locations or times in order to have flexible and various ways of broadcasting the system list to the mobile station.

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5. Claims 8-11 and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Nizri.

Regarding claims 8-11 and 16-18, Nizri discloses the method of claims 1 and 13 as described above. Nizri, however, fails to disclose where and how often to broadcast the above list as recited in the claims. However, the examiner believes that the above recitations would not render the claims patentable over the applied references because they merely depend on where and how often one would like to broadcast the list, without changing the scope of the invention in the applied references. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention, to broadcast the system list at various locations or times in order to have flexible and various ways of broadcasting the system list to the mobile station.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 8:00am-5:00pm.

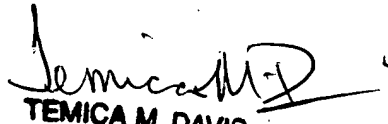
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis
Examiner
Art Unit 2681

August 23, 2004


TEMICA M. DAVIS
PATENT EXAMINER